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Dated: June 4, 2003
Signature: *Harvey L. Cohen*
(Harvey L. Cohen)

Docket No.: COSTEL 3.0-001
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Pamella A. Costello

Application No.: 09/823,430

Filed: March 30, 2001

For: KEYBOARD PROTECTIVE COVER

: Group Art Unit: 2854
: Examiner: A. Nguyen

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

RESPONSE TO OFFICE ACTION

Dear Sir:

In response to the Official Action mailed March 6, 2003, Applicant submits the following response. Reconsideration of the claims and entry of the remarks is respectfully requested.

REMARKS

Claims 1-19 are pending in the Office Action mailed March 6, 2003. All claims have been rejected; reconsideration is requested in view of the following remarks.

Claim 19 has been rejected under 35 U.S.C. § 112, second paragraph. The Examiner explains that the scope of the claim is unclear since the preamble of the claim appears to recite a method of avoiding the transmission of disease-carrying organisms, but the step of avoiding such transmission is not cited. The Examiner concludes that the claim language appears to be improper since no step for performing the desired step is provided. This rejection is traversed.

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The Examiner's attention is invited to claim 19, having been amended in the previous Office Action. In particular, the relevant portion of the claim presently reads as follows: "having said at least one user apply to said keyboard prior to use thereof, and removing prior to use of said keyboard by another, of a personal, easily removable keyboard cover to said keyboard by said user, said cover comprising ...". (emphasis added) It will be observed that the claim as currently constructed includes steps of applying and removing a keyboard cover to a keyboard, the cover comprising the cover of the present invention. Thus, process steps are included in the claim. It is respectfully requested that the rejection under 35 U.S.C. § 112 be withdrawn since the language of the claim includes a step for performing the desired step.

Turning now to the art rejections of record, claims 1-18 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Nopper et al.* (U.S. 5,021,638) in view of *LEBEAU et al.* (U.S. 2001/0041088 A1). This rejection is respectfully traversed.

The Examiner explains that *Nopper* teaches a keyboard cover having top, side, front and rear panels, as shown in FIGS. 3 and 3A. The Examiner also acknowledges that *Nopper* fails to teach that the top panel does not correspond to depressions or elevations of a specific keyboard array as in the present claims. It is further explained that *LEBEAU* teaches a keyboard cover having a top panel which does not correspond to the depressions or elevations of a keyboard (referring to FIGS. 6 and 7). The Examiner explains that it would therefore have been obvious to one of ordinary skill in the art to modify the keyboard of *Nopper* by providing the top panel as taught by *LEBEAU* for reducing the manufacturing cost of the keyboard cover. The Examiner additionally explains that with respect to

claim 6, the use of a keyboard cover having side panels with less elasticity than the top panel is "well known in the art." With respect to claims 10-14, the Examiner states "the selection of a desired material for forming the cover involves only an obvious matter of design choice based upon obvious experimentation." This rejection is respectfully traversed.

As explained above, the Examiner relies on *LEBEAU* to provide for the deficiencies of *Nopper*. However, *LEBEAU* does not qualify as prior art in the present application. It is noted on the cover page of *LEBEAU* that it was published on November 15, 2001. In contrast, the present application relies for priority on a provisional application filed April 4, 2000 and a utility application having a filing date of March 30, 2001. Consequently, *LEBEAU*, having published after the filing date of the priority and utility applications and not having issued as a patent, cannot qualify as a prior art reference under 35 U.S.C. § 103(a). On this basis alone, the rejection fails to render obvious the claims of the present application since the Examiner admits that *Nopper* does not render the application obvious and *LEBEAU* does not qualify as prior art. Withdrawal of the rejection is respectfully requested.

Additionally, *Nopper* is cited for the teaching that a keyboard cover has top and side panels. However, it is respectfully noted that the pending claims were previously amended specifically to distinguish over *Nopper*, in that "the top panel cross-section does not correspond to the depressions or elevations of a specific keyboard array." The Examiner appears to acknowledge this failing of *Nopper* and cites *LEBEAU* as teaching a top panel which does not have such depressions or elevations. However, it is unclear how a reference such as *Nopper*, one that specifically illustrates a keyboard cover having depressions and elevations, is combinable with one in

which such depressions and elevations are absent. The Examiner suggests that it would have been obvious to one of ordinary skill in the art to modify the keyboard of *Nopper* by providing the top panel taught by *LEBEAU* for reducing the cost of manufacture of a keyboard cover. However, while such a teaching is present in the instant specification, there is no teaching in either of the references such that the motivation adopted by the Examiner would be obvious to one of ordinary skill in the art. Overall, *Nopper* is directed to a totally different approach that is not relevant to the claims currently under consideration.

Furthermore, assuming solely for the sake of completeness that *LEBEAU* can be considered as prior art, *LEBEAU* fails to teach or suggest a keyboard cover exhibiting elastomeric properties as required by the claims. While the Examiner has commented that the selection of desired materials for forming the cover is an obvious matter of design choice, such an argument fails to appreciate the significant differences in performance properties for an elastomeric cover as compared to the cover described in *LEBEAU*. This difference is further supported by the figures in the *LEBEAU* reference which illustrate that the invention in that published application comprises a sleeve into which the computer keyboard is slid. In order to do so, such a cover would need to have a reasonable degree of rigidity. This is additionally supported by the disclosure of *LEBEAU* which fails to identify elastomers as useful materials. Further, the cover disclosed and claimed in the instant application is elastomeric and stretches to fit around the keyboard itself, and the quality of "stretch" in the present invention is recited as a limitation in the claims. Consequently, while *LEBEAU* has some similarities to the present invention, it fails with regard to a key characteristic as

presently claimed. Withdrawal of the rejection on this basis is respectfully requested.

The Examiner states that claim 6 is rejected since a keyboard cover having side panels having less elasticity than a top panel is "well known in the art." It is respectfully suggested that this rejection is inadequate since no basis is provided for the Examiner's conclusion regarding the elasticity differential recited in claim 6. Additionally, while claims 10-14 recite a selection of materials, in each instance they incorporate a characteristic of the independent claim, namely, elasticity, that is unique to the present invention. Therefore, claims 10-14 are patentable since claim 1 is patentable for the reasons explained above.

Finally, regarding the differential property of elasticity, the Examiner refers to both *Nopper* and the reference *Matone* (U.S. 4,758,712) as disclosing bottom panels made of steel, aluminum or plastic which are said to have less elasticity than the top panel. It is respectfully suggested that such an argument is without merit, since the present invention is directed to an overall structure having elasticity whereas the references in which steel and aluminum are equated with a plastic clearly suggest that elasticity is not a relevant property. Such constructions would not suggest to one of ordinary skill in the art the features of claims 10-14 unless the Examiner relies on the present disclosure to teach the benefit of such an arrangement. However, to do so is not an appropriate basis on which to reject these claims. Withdrawal of this aspect of the rejection is respectfully requested.

In conclusion, the Examiner acknowledges that *Nopper* is inadequate to reject the instant claims. Additionally, *LEBEAU* is not prior art in the instant application. Finally, even if *LEBEAU* is considered, it fails to teach or suggest the

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features of the claims as instantly presented. Withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that he telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which he might have.

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: June 4, 2003

Respectfully submitted,

By 

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